

Serial No.: 10/769,768
Docket No.: 101-1013
Amendment After Final dated November 18, 2008
Reply to the Final Office Action of September 18, 2008

REMARKS

Introduction

Applicant notes with appreciation the Examiner's indication that claim 9 would be allowable if rewritten in independent form, after overcoming 112, second paragraph rejection. It is respectfully submitted that all the pending claims are allowable for at least the reasons set forth below.

Upon entry of the foregoing amendment, claims 1-16 are pending in the application. Claim 9 has been amended. No new matter is being presented.

Entry of this Amendment After Final is proper under 37 C.F.R. §1.116 because the claim amendments: (a) place this application in condition for allowance (for the reasons discussed herein), (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution as indicated in the Final Office Action), (c) present the rejected claims in better form for consideration on appeal (should an appeal be necessary), and (d) are necessary and were not earlier presented because they are made in response to arguments raised in the Final Office Action.

Accordingly, for at least the reasons discussed above, entry of this Amendment is respectfully requested.

In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Objection to the Drawings

The drawing of FIG. 9 is objected to under 37 CFR 1.83(a) because it fails to show a legend describing the labels on the Figure as described in the specification.

Applicant has amended FIG. 9 to include a legend describing reference numbers 138 and 140 as the "FIRST MODULE JACK" and the "SECOND MODULE JACK," respectively. Support for this legend can be found, for example, in paragraph [0059] of the specification. No

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new matter is being added.

Accordingly, it is respectfully submitted that the objection to the drawing of FIG. 9 has been fully addressed and overcome, and withdrawal of the objection is respectfully requested.

Rejection under 35 USC §112

Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 9 to clarify “a transistor which has a collector to receive the extracted current and a base to receive the internal current...” Support for this amendment can be found, for example, in Fig. 9 and paragraphs [0060-0061].

Accordingly, it is respectfully submitted that the rejection to claim 9 under 35 U.S.C. §112, second paragraph, has been fully addressed and overcome, and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC §103

1. Claims 1, 4-6, 8, and 10-14

Claims 1, 4-6, 8 and 10-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant Admitted Prior Art (hereinafter “AAPA”) in view of U.S. Patent No. 6,434,232 to Ludeman (hereinafter “Ludeman ‘232”). Reconsideration and withdrawal of the rejection is respectfully requested for at least the following reasons.

Claims 1 and 6

On page 5 of the Office Action, the Examiner relies on page 1, paragraphs 0003, 0004 of Applicant’s specification to allege that AAPA teaches “the main terminal maintains the loop voltage generated when the external terminal is in connection with the telephone network.”

The Examiner also contends in the Examiner’s “Response to Arguments” on page 2 of

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the Office Action that “[t]he applicant did not claim that the main terminal maintains the **constant** loop voltage generated when the external terminal is in connection with the telephone network.”

Based on the portion of the Examiner’s “Response to Arguments” reproduced above, it appears the Examiner has misconstrued Applicant’s invention, because nowhere does Applicant’s invention require the main terminal to maintain a “**constant**” loop voltage when the external terminal is in connection with the telephone network. Instead, the subject claims recite that “the main terminal ***maintains*** the loop voltage generated when the external terminal is in connection with the telephone network,” i.e., “when the telephone network is disconnected from the external terminal and connected to the main terminal.” One of ordinary skill in the art will appreciate that “maintains the loop voltage” is not the same as “different loop voltages.”

Accordingly, Applicant respectfully submits that AAPA and Ludeman ‘232, whether taken alone or in combination with one another, fail to teach or suggest, among other things, “the main terminal ***maintains*** the loop voltage generated when the external terminal is in connection with the telephone network,” as recited in claims 1 and 6, for at least the following reasons.

Unlike the present invention, AAPA’s first and second loop voltages are not the same, but instead, in fact, are different (paragraph [0004]). AAPA relates to a system such that when the external terminal is disconnected from the telephone network and the main terminal is connected, the voltage changes from the second loop voltage to the first loop voltage (see, paragraphs [0004] and [0005] of Applicant’s specification).

For example, as illustrated in FIGS. 1A and 1B of AAPA, when the second DC current signal (section B) is different than the first DC current signal (section C), an interrupt “9” may be generated when the state of the connection with the telephone network is changed, that is, when the second DC current signal changes to the first DC current signal (FIGS. 1A and 1B, paragraph [0005]). This is clearly not the same as “the main terminal ***maintains*** the loop voltage generated when the external terminal is in connection with the telephone network,” as recited in claim 1, and as similarly recited in claim 6, for at least the reason the second DC current signal of AAPA is different than the first DC current signal.

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As to Ludeman '232, the Examiner can point to no language or Figure of Ludeman '232 which even remotely relates to that feature of the invention as recited in claims 1 and 6. To the contrary, the Examiner merely relies on Ludeman '232 to allege that the reference teaches "obtaining an internal current from a loop voltage generated (col. 2, lines 27-33)." Accordingly, Ludeman '232 fails to teach or suggest the features that are lacking in AAPA as applied to claims 1 and 6, as pointed out above.

Furthermore, even assuming it would be possible to combine AAPA and Ludeman '232 as submitted in the Office Action mailed on September 18, 2008 (which it is not), the proposed combination would still fail to teach or suggest, among other things, "the main terminal maintains the loop voltage generated when the external terminal is in connection with the telephone network," as recited in claims 1 and 6.

It is well-settled that "[t]o establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Since AAPA and Ludeman '232 fail to teach or suggest all of the features of the invention as recited in claims 1 and 6, these claims are patentably distinguishable over AAPA and Ludeman, whether taken alone or in combination with one another, and withdrawal of the rejection and allowance of claims 1 and 6 are respectfully requested.

Claims 4, 5, 8, and 10-14

With regard to dependent claims 4, 5, 8, and 10-14, it is respectfully submitted that for at least the reason that these claims depend from one of independent claims 1 and 6, respectively, and therefore contain all of the features recited therein, dependent claims 4, 5, 8, and 10-14 are also allowable over the cited references, for at least the reasons in which independent claims 1

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and 6 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claims 4, 5, 8, and 10-14 are respectfully requested.

2. Claims 2, 3, and 7

Claims 2, 3 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Ludeman '232 and further in view of U.S. Patent No. 6,757,378 to Kunisch. Reconsideration and withdrawal of the rejection are respectfully requested for at least the following reasons.

Applicant respectfully references MPEP §2143.03, which states that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, for at least the reason that claims 2, 3, and 7 depend from one of independent claims 1 and 6, respectively, and therefore contain all of the features recited therein, dependent claims 2, 3, and 7 are also allowable over the cited references, for at least the reasons in which independent claims 1 and 6 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claims 2, 3, and 7 are respectfully requested.

3. Claims 15 and 16

Claims 15 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of U.S. Patent No. 6,665,398 to Ludeman (hereinafter "Ludeman '398"). The rejection is traversed for at least the following reasons.

Claim 15

On page 11 of the Office Action, the Examiner contends that claim 15 is rejected for the same reasons as claim 1. While the Examiner admits that AAPA does not specifically teach a controller controlling the loop voltage constant according to the internal signal, the Examiner alleges that this feature is taught or suggested by Ludeman '398.

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Before addressing the Examiner's rejection of claim 15, it is noted that the Office Action does address all of the features recited in claim 15. Upon review of the Office Action, nowhere does the Examiner indicate where Ludeman '398 allegedly teaches "controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected to the main terminal," as recited in claim 15. Instead, the Examiner merely states that Ludeman '398 teaches "a controller controlling the loop voltage constant according to the internal signal," and then jumps to the conclusion that it would be obvious to modify AAPA to keep the voltage constant so that the loop current can somehow be reduced to a value below a threshold value. However, even assuming this is true (which it is not), this does not establish where the cited references allegedly teach or suggest "controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected to the main terminal," as recited in claim 15.

Since the Office Action has neglected to indicate where the cited references allegedly teach or disclose all of the features recited in claim 15, Applicant respectfully submits that the present Office Action fails to comply with proper examination requirements contained in MPEP §706.07, which states in part that "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing," and "in making the final rejection...any such grounds relied on...must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal." Applicant is thus unclear as to the Examiner's specific reasons for rejecting claim 15, and submits that Applicant has been denied a full and fair hearing with respect to the subject matter of claim 15.

Should the Examiner maintain the rejection of claim 15 upon consideration hereof, the Examiner is respectfully requested to issue a second non-final Office Action, clearly articulating where the cited reference allegedly teaches all of the features recited in claim 15, providing Applicant with a fair opportunity to respond to the Examiner's allegations as to whether any of the claimed features or process operations are the same or different from the cited reference. In the interest of clearly defining the issues, Applicant respectfully requests withdrawal of the finality of the Office Action mailed on September 18, 2008.

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Notwithstanding the improper rejection of claim 15, Applicant provides a clear distinction between Ludeman '398 and the invention as recited in claim 15, in an effort to expedite prosecution to a successful conclusion.

Applicant respectfully submits that Ludeman '398 fails to teach or suggest, among other things, "controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected to the main terminal," as recited in claim 15. In contrast, although Ludeman '398 provides a constant loop voltage (V_{on}) when the SLIC is in an on-hook state, Ludeman '398 requires the loop voltage to change when the SLIC transitions to an off-hook state (Ludeman '398, col. 5, lines 23-24). That is, Ludeman '398 merely provides a constant loop voltage V_{on} when the SLIC is in a on-hook state. However, when the SLIC transitions to an off-hook state, a different loop voltage V_{off} is provided, (Ludeman '398, col. 5, lines 13-24; FIG. 6). Ludeman '398 thus limits itself to a system which provides different loop voltages depending on whether the SLIC is in a on-hook or off-hook. This is not the same as "a controller controlling the loop voltage constant according to the internal signal when the telephone network is disconnected from the external terminal and connected to the main terminal," as recited in claim 15, for at least the reason that providing "different" loop voltage is not the same as "controlling the loop voltage constant" when the telephone network is switched.

Furthermore, since Ludeman '398 makes clear that an essential feature of their invention is to apply a first voltage level in the on-hook condition, and to apply a second voltage in the off-hook condition, one of ordinary skill in the art would not attempt to modify Ludeman '398 to provide a constant voltage when the telephone network is disconnected from the external terminal and connected to the main terminal, for at least the reason that this would mean destroying the intended purpose of Ludeman '398, which is to provide a different loop voltage V_{off} when the SLIC transitions to an off-hook state.

It is well established that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). References are not properly combinable or modifiable if their intended function is destroyed. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125

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(Fed. Cir. 1984). Since the intended function of Ludeman '398 would be destroyed if the reference is modified to arrive at all of the features recited in claims 1 and 6, the reference cannot be properly used to reject claims 1 and 6 under 35 U.S.C. 103(a) as submitted in the Office Action mailed on September 18, 2008.

For at least the above reasons, it is respectfully submitted that claim 15 is patentably distinguishable over AAPA and Ludeman '398, either separately or combined, and withdrawal of the rejection and allowance of claim 15 are respectfully requested.

Claim 16

For at least the reason that claim 16 depends from independent claim 15, and therefore contain all of the features recited therein, dependent claim 16 is also allowable over the cited references, for at least the reasons in which independent claim 15 is allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claim 16 are respectfully requested.

In addition to the fact that claim 16 depends from independent claim 15 as pointed out above, claim 16 is also allowable for its own reasons, since the cited references fail to teach or suggest, among other things, "the controller controls the first DC supply unit to ***maintain*** the loop voltage constant when the telephone network is switched from the external terminal to the main terminal," as recited in claim 16, for at least the reasons provided above.

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Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

STANZIONE & KIM, LLP

Dated: November 18, 2008
919 18th St., NW, Suite 440
Washington, DC 20006
Telephone: (202) 775-1900
Facsimile: (202) 775-1901

By: 
Andrew Lake
Registration No. 53,909